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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,951	11/26/2001	Chit Wei Saw	10012969-1	5223

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/991,951

Applicant(s)

SAW ET AL.

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-17, 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9306. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 2, 8, 10, 12, 13, and 18-20 have been amended for further examination. Claims 21-36 have been added.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1, 2, 4, 8, 13, 14 and 21-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Michaelis et al (2002/0057453).

Michaelis et al discloses a cover authoring tool and method comprising: an interface (microprocessor and program memory as stated in Col. 2, Par. 12, and in) for receiving size data information for a document to be bound into a book, having a spine characterized by a width dimension (thickness. Par. 14, and for receiving graphical and textual content information for a cover (Par. 13) to be attached to a bound book; a cover content layout engine (Fig. 2) configured to compose a final content layout for the cover, including spine content formatted to accommodate the book dimensions based upon document size and cover content information received through the interface (Par. 15 and par. 21), wherein the cover content layout engine is configured to compute the thickness dimension (Par. 21, lines 3 and 4).

In regards **Claims 1, 21-31**, the method of configuring a layout engine by scaling content received, formatting the content, compute a bounding box, to set a height and width related typeface parameter, and composing the final content layout, and wherein the interface is configured to receive content does not structurally limit the claim. The patentability of a product

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does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to configure the engine layout by any desirable method.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 20 and 32-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosasa et al (5,735,659).

Kosasa et al discloses in Fig. 1-2A, a bookbinding system comprising a sheet composer configured to format a document to be bound (202); a sheet binder (203) configured to form a text body of two or more sheets having an exposed spine characterized by dimensions; a cover authoring tool comprising an interface (306) configured to receive size information and content information for a cover, a cover content layout engine (317) configured to compose a final content layout for the cover including the spinal content to accommodate the dimensions for the book spine and cover content (Col. 9, lines 44-58); and a cover binder (203) configured to attach the cover to the text body.

In regards **Claims 20, 32-36**, the method of configuring a layout engine by scaling content received and formatting the content, composing the final content, computing a bounding box, and

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setting height and width related typeface parameters; wherein the interface receives content for a back cover, receives content for a wrap-around region does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see MPEP 2113). Therefore, it would be obvious to configure the engine layout by any desirable method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Carlson et al (WO-01/00423).

Michaelis et al discloses a cover authoring tool comprising all the elements as claimed in Claims 1 and 2 and as set forth above. However, Michaelis et al does not disclose wherein the

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received document size information includes type of paper and number of pages in the bound book.

Carlson et al discloses in the Abstract wherein the received information for the cover content layout engine includes the type of paper and the number of pages in the book.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool with received information comprising type of paper and number of pages included as taught by Carlson et al for the purpose determining the size requirements for the cover.

5. Claims 5-7, 15, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Tonkin (6,616,702).

Michaelis et al discloses a cover authoring tool and method comprising all the elements as claimed in Claims 1 and 4 and as set forth above. However, Michaelis et al does not disclose wherein the interface comprises a graphical user interface in which a user may specify the content and content layout for the cover; and wherein the interface is configured to compose the final content layout for the cover based upon a pre-generated cover style.

Tonkin discloses in Col. 6, lines 62-65, a graphical user interface (Fig. 5A and 5B) in which a user may specify the content and content layout for the cover (Col. 11, lines 20-50) based upon multiple pregenerated cover styles (Col. 7, lines 38-45).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool and method with a graphical user interface as taught by Tonkin for the purpose of allowing the end user to edit book contents and the cover layout to user's specifications.

6. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michaelis et al in view of Kosasa et al (5,735,659).

Michaelis et al discloses a cover authoring tool and method comprising all the elements as claimed in Claim 1, and as set forth above. However, Michaelis et al does not disclose wherein the content cover layout engine is configured to select the typeface parameters (which include the font size) for spinal text content consisting of a number of characters; and wherein the typeface values are selected from the group consisting of one of the following typeface parameters: font size, spread, stretch font variation, and font weight.

Kosasa et al discloses in Col. 9, lines 44-58 wherein a content layout engine (thickness detection sensor is configured to select the typeface parameters for the spinal text content, wherein the typeface values consist a font size parameter. (Col. 9, lines 53-58).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Michaelis et al's cover authoring tool with a content layout engine configured to select the typeface for the spinal text as taught by Kosasa et al for the

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purpose of reducing the bookmaking manufacturing time by having the system itself calculate the correct parameters to print on the cover spine.

In regards to **Claim 10 and 12**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore, typeface parameter is capable of being selected for a stretch font variation, and capable of being based upon the number of characters of the spinal text content, height and width dimensions of the book spine.

Allowable Subject Matter

7. Claims 18 and 19 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a cover authoring method comprising receiving size information for a document to be bound into a book; receiving content information for a cover to be attached to the book; composing a final content layout for the cover including spinal content formatted to

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accommodate width and height dimensions of a the book spine; and selecting typeface parameter values for spinal text content consisting of a number of characters, wherein the typeface parameter values are selected based at least upon the number of characters of spinal text content and height and width dimensions of the book spine; and wherein the typeface values are selected for on of: weight axis, width axis, style axis and optical size axis; and including all of the other limitations of the independent claims.

Response to Arguments

9. Applicant's arguments filed on March 24, 2004 have been fully considered but they are not persuasive.

In response to applicant's arguments that Michaelis fails to disclose the product-by-process method of scaling the front cover content, formatting the spinal region to accommodate the width and height dimensions of the book spine, the examiner has reviewed the claims in further depth, has withdrawn the previous allowable subject matter and has rejected the amended and new claims, since the method of configuring a layout engine by scaling content received, formatting the content, compute a bounding box, setting a height and width related typeface parameter, and composing the final content layout does not structurally limit the claim. The patentability of a product does not depend on its method of production. If the product in the

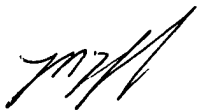
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product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art was made by a different process (see *MPEP 2113*).

Therefore, it would be obvious to configure the engine layout by any desirable method.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 14, 2004



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